

Exhibit A

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16 **IN THE UNITED STATES DISTRICT COURT**
17 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
18 **OAKLAND DIVISION**

19 FINJAN, INC.,

20 Plaintiff,

21 v.

22 QUALYS INC.,

23 Defendant.

Case No.: 4:18-cv-07229-YGR

**PLAINTIFF FINJAN, INC.’S [PROPOSED]
RESPONSE TO DEFENDANT QUALYS,
INC.’S OBJECTION TO EVIDENCE
[DKT. 60]**

Date: May 1, 2020¹
Time: 10:00 AM
Place: Courtroom 1, 4th Floor
Judge: Hon. Yvonne Gonzalez Rogers

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¹ Subject to the Court’s March 12, 2020 Order (Dkt. No. 48) expanding in person appearances

1 **I. INTRODUCTION**

2 The Court should overrule Qualys' Objections to Evidence (Dkt. No. 60, "Objections") and
3 accept the declaration of Dr. Goodrich in support of Finjan's reply claim construction brief. Finjan
4 offers Dr. Goodrich's declaration to rebut the invalidity opinions of Qualys' expert. Pursuant to Patent
5 Local Rule ("PLR") 4-2, Finjan timely disclosed that it would rely on Dr. Goodrich's opinions for
6 rebuttal five months ago, which is fatal to Qualys' Objection. PLR 4-5(c) expressly permits Finjan to
7 provide such new evidence on reply to rebut evidence that a defendant submits with its responsive brief,
8 which is exactly what happened here. Qualys submitted Dr. Rubin's declaration with its response brief
9 in support of its invalidity argument, a defense for which Qualys bears the burden of proof and burden
10 of production. Finjan offers Dr. Goodrich's declaration to rebut Dr. Rubin's declaration, as expressly
11 permitted by PLR 4-5(c). Thus, there is no merit to Qualys' Objections.

12 **II. STATEMENT OF FACTS**

13 The parties exchanged PLR 4-2 disclosures on November 6, 2019, and Finjan served amended
14 disclosures on November 12, 2019. Dkt. 60-1, Declaration of Christopher D. Mays ("Mays Decl."),
15 Exs. E and F. On December 4, 2019, the parties submitted their PLR 4-3 Joint Claim Construction
16 Statement. Dkt. 40. In both its PLR 4-2 disclosures, and again in the JCCS, Finjan expressly disclosed
17 that, to the extent Qualys offered an expert opinion that the terms "transmitter" and "receiver" are
18 indefinite, Finjan would offer a rebuttal opinion from Dr. Goodrich:

19 Finjan will rely on expert testimony to rebut Qualys' proposed expert opinion that
20 "a person of ordinary skill in the art as of the priority dates of the respective patents,
21 reading the respective patents' specifications, would not be able to identify
22 corresponding structure for the term ['receiver.']/['transmitter']"

23 Mays Decl., Ex. E at 8-9, 17-19, and 25-26; *see also* Dkt. 40 (JCCS) at 7, Ex. A at 4-10, 16-19 and 25.

24 Qualys' disclosure of proposed expert opinions in the Joint Claim Construction Statement was
25 far more ambivalent than Finjan's disclosure. For example, Qualys disclosed the following for the term
26 "transmitter," which is just the inverse of Finjan's disclosure:

27 Dr. Aviel Rubin . . . may opine that a person of ordinary skill in the art as of the
28 priority dates of the respective patents, reading the respective patents' specifications,
29 would not be able to identify corresponding structure for the term "transmitter."

30 Dkt. 40 (JCCS). Ex. A at 10.

1 Finjan filed its Opening Claim Construction Brief on February 10, 2020. Dkt. 42. Qualys filed
2 its Responsive Brief on March 16, 2020. Dkt. 52. Qualys submitted a declaration from Dr. Rubin with
3 its Responsive Brief in which Dr. Rubin opined that the terms “receiver” and “transmitter” are
4 indefinite. Dkt. 52-6. Finjan filed its Reply on April 6, 2020, and submitted the Declaration of Dr.
5 Goodrich for the purpose of rebutting Dr. Rubin’s invalidity opinions. Dkt. 59; Dkt. 59-1.

6 **III. ARGUMENT**

7 **A. Dr. Goodrich’s Declaration is Proper Rebuttal Evidence Under the PLR**

8 The PLR permitted Finjan to submit Dr. Goodrich’s declaration with its reply claim
9 construction brief. Dr. Goodrich’s declaration is a direct rebuttal to Dr. Rubin’s declaration on
10 invalidity, which Qualys submitted with its responsive brief. The PLR provide that “the party claiming
11 patent infringement... shall serve and file any reply brief *and any evidence directly rebutting the*
12 *supporting evidence contained in an opposing party’s response.*” PLR 4-5(c) (emphasis added).
13 Because the PLR expressly authorize such submissions, Civil Local Rule 7-3(d), upon which Qualys’
14 Objections are premised, does not apply.

15 For this reason, Qualys’ arguments that Dr. Goodrich’s opinions are untimely and were not
16 sufficiently disclosed fail. Finjan could not have submitted Dr. Goodrich’s rebuttal evidence in its PLR
17 4-2 disclosure or its opening brief because it had no way of knowing what evidence to rebut. Qualys’
18 short and ambivalent disclosure under PLR 4-2 simply declared that an expert “may” opine regarding
19 the “transmitter” term. Dkt. 40, Ex. A at 10. Qualys did not provide a definitive declaration that it was,
20 in fact, providing an expert opinion or the substance of that possible disclosure. As such, Finjan learned
21 for the first time the specifics of Dr. Rubin’s opinion would when it received Qualys’ responsive brief.²

22 Courts in this District recognize that PLR 4-5 permits submission of new rebuttal evidence for
23 the first time on reply. *Competitive Techs. v. Fujitsu Ltd.*, 286 F. Supp. 2d 1161, 1169 (N.D. Cal. 2003)
24 (“Patent Local Rule 4–5 expressly permits such rebuttal testimony.”). *Competitive Technologies* is
25 instructive because there, as here, the defendant filed Objections to Evidence under the civil local rules
26

27 ² Qualys initially disclosed that it may rely on expert opinions for ten terms, and later narrowed those
28 terms to “receiver” and “transmitter,” but did not inform Finjan of this narrowing until it filed the
responsive brief. Dkt. 40, Ex. A at 4, 10, 16, 19, and 25.

1 to seek to exclude an expert declaration filed with the reply claim construction brief. *Id.* In that case,
2 the Court rejected the same argument that Qualys asserts here because “at least part of [the expert]’s
3 declaration constitutes rebuttal,” which is permitted under PLR 4-5(c). *Id.* Further, *Competitive*
4 *Technologies* also rejected the defendant’s argument that some evidence in the declaration went beyond
5 rebuttal, since the defendant had an opportunity to address any such evidence at the claim construction
6 hearing. *Id.*; *Genentech, Inc. v. Trustees of the Univ. of Penn.*, No. 10-cv-02037-LHK, 2011 WL
7 866599, at *2 (N.D. Cal. Mar. 10, 2011)(allowing new evidence on reply to rebut new evidence in the
8 claim construction response, because “[j]ustice is best served when issues are decided on the merits”).

9 This application of the PLR to permit reply declarations in response to invalidity arguments
10 makes sense because Qualys, as the proponent of the indefiniteness defense and of the requisite
11 showing that these are means-plus-function elements despite the absence of the word “means,” bears
12 the burden of production on its defense. *Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1372-74
13 (Fed. Cir. 2003) (party seeking to overcome presumption that an element is not a means-plus-function
14 element if it does not use “means” bears the burdens of production and proof); *Core Wireless Licensing*
15 *S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1363 (Fed. Cir. 2018) (defendant bears “the initial burden of
16 going forward with evidence to support its invalidity allegation” and the burden of proof by clear and
17 convincing evidence). Therefore, Finjan should have an opportunity to respond after Qualys has
18 attempted to demonstrate indefiniteness.

19 The only case that Qualys cites does not support its Objections because it dealt with very
20 different facts from those presented here. *See Quantum Corp. v. Crossroads Sys., Inc.*, No. C 14-04293
21 WHA, 2015 WL 5693734, at *5 (N.D. Cal. Sept. 29, 2015). In *Quantum Corp.*, an expert’s opinions
22 were excluded because he refused to answer questions at his deposition regarding the opposing party’s
23 claim constructions, claiming he had no opinions, but later asserted those opinions on reply. *Id.* at *3
24 (“Dr. Hospodor gave opinions rebutting Crossroads’ proposed constructions in his declaration, although
25 he claimed he had no such opinions at his deposition”). Here, by contrast, Qualys never sought to
26 depose Dr. Goodrich and, therefore, there is no situation where Dr. Goodrich refused to answer
27 questions or claimed he had no opinion on an issue.

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